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Patent
Case No.: 54537US003

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

First Named Inventor: FAGAN, MARK E.
Application No.: 09/185208 Group Art Unit: 1772
Filed: November 3, 1998 Examiner: N. Ahmad
Title: FILLED LAB PATTERN-COATED FILMS

BRIEF ON APPEAL

Board of Patent Appeals
and Interferences
Commissioner for Patents
Washington, DC 20231

<u>CERTIFICATE OF MAILING</u>	
I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Commissioner for Patents, Washington, DC 20231 on:	
Date 25 July 2002	Signed by: Carolyn V. Peters

Dear Sir:

This is an appeal from the Office Action mailed on December 13, 2001. This Brief is being filed in triplicate. The fee required under 37 CFR § 1.17(c) for the appeal should be charged to Deposit Account No. 13-3723. The fee for an oral hearing will be submitted at the appropriate time.

REAL PARTY IN INTEREST

The real party in interest is 3M Company (formerly known as Minnesota Mining and Manufacturing Company) of St. Paul, Minnesota and its affiliate 3M Innovative Properties Company of St. Paul, Minnesota.

RELATED APPEALS AND INTERFERENCES

Appellants are unaware of any related appeals or interferences.

STATUS OF CLAIMS AND AMENDMENTS

Claims 1-14 are rejected and all amendments have been entered.

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SUMMARY OF THE INVENTION

A coated article is provided having a textured film backing with a top surface and a bottom surface, and the top surface has a layer of pattern-coated low adhesion backsize (LAB),

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such that there are areas that are coated and areas that are uncoated and the appearance of the coated and uncoated areas on a textured film is visibly uniform. Advantageously, the coated film has a surface that has visually indiscernible areas, even when at least one portion of the film is coated with LAB, and the remainder of the film is uncoated. This is particularly advantageous for articles using textured films, although the present invention provides the same advantages for non-textured films, as well.

When referring to pattern coated films having at least one uncoated area, "visibly uniform" means that the 60 degree film gloss of the coated and uncoated areas are within $\pm 50\%$ of the uncoated textured film gloss. When referring to patterned coated films having no uncoated areas, "visibly uniform" means the 60 degree film gloss of the coated areas are within $\pm 50\%$ of the 60 degree film gloss of the lowest gloss value of the coated areas.

LABs used in the present invention contain at least one particulate filler, typically an inorganic filler, such as amorphous silica or alumina and the diameter of the particles is in the range of the topographical features of the textured film and the thickness of the LAB and such diameter is typically in the range of 1 to 10 micrometers. Generally, the filler is present in the range of 1 to 15 parts by weight of the low adhesion backsize coating preferably 6 to 10 parts by weight.

Alternatively, the present invention provides a coated film having a film with a top surface and a bottom surface, and the top surface has a layer of pattern-coated low adhesion backsize (LAB), such that there a first area coated with a first LAB and a second area coated with a second LAB and the appearance of the two coated areas on the film are visibly uniform. Advantageously the coated film has a surface that has visually indiscernible areas, even when at least one portion of the film is coated with a first LAB, and the remainder of the film is coated with a second LAB. This is generally not an issue until, the coating weights differ, pattern-coating with the first coating area or the compositions of the LABs differ, in which case the coatings on a textured film may appear different and the pattern becomes visible.

Advantageously, the present invention enhances the use of pattern-coated LABs provides a range of release levels, as well as allowing differential release, while providing a visually uniform appearance of such pattern-coated textured films.

ISSUES ON APPEAL

1. Whether or not "how to coat a film" is germane to the issue of patentability of the product itself.
2. Whether or not undue experimentation to obtain the article of present invention on the basis of the Butler reference gives rise to "obvious to try".
3. Whether or not the combinations of Butler in view of Zhu and further in view of Blackwell make the claims 1-14 obvious.

GROUPING OF CLAIMS

The appealed claims will stand or fall together. No admission, however, is being made with respect to the obviousness of the subject matter of the dependent claims with respect to the subject matter of the independent claims.

ARGUMENTS OF APPELLANTS

The Examiner has stated that Butler refers to a textured film having a layer of permanent adhesive on one surface and a layer of low adhesion backsize (LAB) on the opposite surface. The LAB is pattern-coated on the film and includes a silica particulate as fillers. However, Butler fails to teach that the LAB coated film surface is visually uniform. The Examiner further states that Zhu discloses a coating composition of LAB comprising colloidal silica dispersion wherein the particle size can be larger and will not diminish LAB properties but changes the visual properties. Therefore, it would have been obvious to one having ordinary skill in the art to utilize Zhu's teaching of using large size silica particles in LAB in the invention of Butler to obtain visual uniformity of the film surface.

Appellants understand Butler as teaching a process for a coating that is a non-reproducible random coating, much like an orange peel effect. Butler obtains splotchy patterned coatings. The "pattern" is unpredictable and non-reproducible, although the coating conditions may be reproduced. Furthermore, what Butler is creating is a microscopic pattern, which is difficult to see (note that the images are SEMS at 50X magnification).

The Examiner further states that the argument "is not deemed to be convincing because 'how to coat a film' is directed to a process condition which is not germane to the issue of patentability of the product itself."

Appellants respectfully disagree. Applicants do not propose that the article of the present invention can only be made using a particular process. However, the teaching in the art with respect to how an article is made is indeed germane to the patentability of an article. If the references cited by the Examiner fail to specifically teach the article of the present invention, it is appropriate to look at the process to determine if the process taught in the reference could make the article of the present invention. Appellants believe this would require an "obvious to try" standard, a standard that is insufficient to find obviousness. The mere need for experimentation to determine parameters needed to make an article is an example of the often rejected obvious-to-try standard and falls short of the statutory obviousness of 35 U.S.C. § 103. (*Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 USPQ 2d 1434 (Fed. Cir. 1988). Lacking any teaching in Butler as to how to accomplish the article of the present invention, one skilled in the art would be left to experiment until such results were obtained. That is, one skilled in the art would require undue experimentation in this "obvious to try" circumstance.

Appellants understand Zhu as teaching the use of colloidal silica in the range of 1 nanometer to 1 micrometer, with a preferred range of 7 to 75 nanometers. Furthermore, Zhu uses silica to improve the abrasion resistance of his coatings (1-12, 2-15, 5-5, etc.).

It appears that Zhu does not measure the optical properties of his coatings, although they are described as "transparent, translucent, or opaque" (Col. 5, Ln 29). Zhu is particularly concerned with the transmissive properties (i.e., degree of transparency) of the cured coatings. This is in contrast to the reflective properties of the present invention, wherein the visual appearance of the film (reflective properties) is what is being claimed, and not whether or not one can view through the film (transmissive properties).

Neither Butler nor Zhu describe how to coat a film with an LAB, such that the film has the appearance of a uniform film, that is the viewer is unable to distinguish between the coated and uncoated macroscopic portions of the film. Uniformity of microscopic portions of the films is not what is being claimed. Butler does not make the present invention obvious and the combination with Zhu, contrary to the Examiner's position, does not cure the shortcomings of Butler.

Appellants respectfully suggest that the rejections based on Butler in view of Zhu are improper and all such rejections should be withdrawn.

Claims 5-6, 9, and 13 under 35 U.S.C. 103(a) have been rejected as being unpatentable over Butler in view of Zhu and Blackwell (5,401,547).

Appellants' arguments set forth above state that the Butler – Zhu combination fails. The addition of Blackwell still does not cure this failure. Merely using two different LABs, as in Blackwell, does not make the use of two different LABs in the present invention obvious. Blackwell describes a fully coated film using two different LABs (for different adhesion levels). However, Blackwell (as well as Butler and Zhu) does not describe or even suggest how to deal with the LAB coated portion of a film and an uncoated portion of the film. Since Blackwell never deals with this issue, there is no suggestion of a modification of the coatings to solve the problem of this interface. Therefore, there is no expectation of success and this combination of references also fails.

Appellants respectfully suggest that the rejections based on Butler in view of Zhu and Blackwell are improper and all such rejections should be withdrawn.

CONCLUSION

For the foregoing reasons, appellants respectfully submit that the Examiner has erred in rejecting this application under 35 USC § 103(a). Please reverse the Examiner on all counts.

Respectfully submitted,

25 July 2002
Date

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APPENDIX

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1. A coated article having a textured film backing with a top surface and a bottom surface, and on the top surface, a layer of pattern-coated particulate filled low adhesion backsize (LAB), such that there are areas on the top surface of the textured film backing that are coated and areas that are uncoated and the appearance of the coated and uncoated areas on a textured film backing is visually uniform.

2. The coated article according to claim 1 wherein the particulate filler is an amorphous silica.

3. The coated article according to claim 1 wherein the particulate filler has a diameter that is greater than the thickness of the low adhesion backsize coating layer.

4. The coated article according to claim 1 wherein the particulate filler is present in the range of 1 to 15 parts by weight of the low adhesion backsize coating.

5. A tape pad comprising pre-cut tape strips disposed one on top of another, such that each tape strip comprises a textured tape film backing having first and second opposite major side surfaces and first and second opposite ends with the first end of each tape strip being in alignment with the second end of an adjacent tape strip in the stack, and a layer of adhesive permanently adhered to the first side surface of the textured tape film backing, the layer of adhesive of each tape strip being releasably adhered along the second surface of the adjacent (lower) tape strip in the pad and the second surface of each textured tape film backing is pattern coated with a particulate filled low adhesion backsize layer.

6. A tape roll comprising a textured tape film backing having first and second opposite major side surfaces, wherein a layer of adhesive is permanently adhered to the first side surface of the textured tape film backing, the layer of adhesive being releasably adhered along the second surface of the adjacent layer of textured tape film backing strip in the roll and the second surface of each textured tape film backing is pattern coated with a particulate filled low adhesion backsize layer.

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7. A coated film comprising a film having a top surface and a bottom surface, and the top surface has a layer of pattern-coated particulate filled low adhesion backsize, such that there is first area coated with a first low adhesion backsize and a second area coated with a second low adhesion backsize and the appearance of the two coated areas on the film are visibly uniform.

8. The coated film according to claim 7 wherein the first and second low adhesion backsize are the same.

9. The coated film according to claim 7 wherein the first and second low adhesion backsize are different.

10. The coated film according to claim 8 wherein the first area and the second area are coated with different patterns.

11. A coated film comprising a textured film with a top surface and a bottom surface, and the top surface has a layer of pattern-coated low adhesion backsize (LAB), such that there are areas that are coated with at least one area coated with a first low adhesion backsize, at least one area coated with a second low adhesion backsize and at least one area that is uncoated, such that the appearance of the two coated areas and uncoated area are visibly uniform.

12. The coated film according to claim 11 wherein the first and second low adhesion backsize are the same.

13. The coated film according to claim 11 wherein the first and second low adhesion backsize are different.

14. The coated film according to claim 12 wherein the first area and the second area are coated with different patterns.